

REMARKS

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph. In order to expedite prosecution, claim 7 has been amended as kindly suggested by the Examiner solely to obviate the alleged indefiniteness. Accordingly, it is respectfully requested that the rejection of claim 7 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Okawa et al. (JP '961) in view of Kotsuki et al. ('974). This rejection is respectfully traversed for following reasons.

A. Proposed combination does not disclose or suggest each and every claim limitation

The Examiner admits that Okawa et al. does not disclose "a caller information detector for detecting caller information from an input signal incoming from the network." The Examiner therefore relies on Kotsuki et al. to modify Okawa et al. by adding a caller information detector. However, even assuming *arguendo* proper, the proposed combination does not disclose each and every limitation of claim 1.

① Claim 1 recites in pertinent part, "wherein audio information corresponding to the caller information is reproduced." Neither Okawa et al. nor Kotsuki et al., alone or in combination, disclose or suggest an audio storage apparatus that can reproduce audio information which corresponds to caller information detected by a caller information detector. Okawa et al. merely discloses a conventional voice storage system without a caller information detector, and Kotsuki et al. merely discloses a conventional caller information detector which detects caller information *for storage purposes* (see col. 4, lines 41-46).

Kotsuki et al. is silent as to any functional relationship between caller information and audio information, let alone using caller information for reproducing audio information corresponding thereto. Accordingly, the proposed combination would simply result in, at best, a voice storage apparatus which can also store caller information, but does not suggest an audio apparatus "wherein audio information corresponding to the caller information is reproduced" as recited in claim 1. In fact, the Examiner does not refer to this limitation in the body of the rejection, and therefore does not appear to assert that the proposed combination discloses this limitation.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

B. Proposed combination is improper

Moreover, it is submitted that the proposed combination is improper because the Examiner has not provided the requisite *objective* evidence *from the prior art* that "suggests the desirability" of the proposed combination. As is well known in patent law, a *prima facie* showing of obviousness can only be established if the prior art "suggests the desirability" of the proposed combination using *objective* evidence.

The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

2 In the instant case, even assuming *arguendo* that Okawa et al. can be modified by Kotsuki et al., it is submitted that the "mere fact that [Okawa et al. and Kotsuki et al.] can be combined ... does not render the resultant combination obvious" because nowhere does the *prior art* "suggest the desirability of the combination" as set forth by the Examiner.

3 Okawa et al. is directed to optimizing transfer of voice data between storage devices while converting voice data between digital and analog signals. Accordingly, there is no disclosed need or desire for a caller information detector, for storing caller information, in the device of Okawa et al.. That is, Okawa et al. is unrelated to the process of determining and/or storing caller information. Furthermore, Kotsuki et al. does not suggest using a caller information detector with a data converting/transfer device.

The Examiner is further directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that Okawa et al. and Kotsuki et al. "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no **objective** reason on the record to combine the teachings of the cited prior art. In contrast, Okawa et al. and Kotsuki et al. are completely silent as to suggesting the **combination** of functionally using an audio storage apparatus with a caller information detector in the manner recited in claim 1.

It is therefore submitted that the proposed combination is based solely on improper hindsight reasoning, whereby the Examiner selected bits and pieces of the prior art and used only Applicant's specification as a guide to reconstruct the claimed invention. At best, the Examiner has attempted to show only that the elements (i.e., audio storage apparatus and caller information detector) of the claimed invention are **individually** known without providing a *prima facie* showing of obviousness that the **combination** of elements recited in the claims is known or suggested in the art. For all the foregoing reasons, it is submitted that the proposed combination of Okawa et al. and Kotsuki et al. is improper.

Moreover, it is respectfully submitted that the Examiner's alleged motivation (i.e., "... for detecting calling party's name, telephone number etc."; *see* page 3, lines 17-19 of outstanding Office Action) is not relevant to the present invention as it relates only to the functionality of a caller information detector independently of any combination and/or functional relationship with an audio storage apparatus.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v.*

Simplimatic Engineering Co., 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that claims 2-9 dependent thereon are also patentable. In addition, it is submitted that claims 2-9 are patentable based on their own merits by adding novel and non-obvious features to the combination for reasons similar to those discussed above with respect to claim 1.


Based on all the foregoing, it is submitted that claims 1-9 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 1-9 under 35 U.S.C. § 103, be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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APPENDIX

7. (Amended) The audio storage apparatus of claim 5, wherein said [mailbox] response message control table includes a response message assigned to a group of plural pieces of caller information.